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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,598	05/30/2001	Domenic Cosentino	COSE3001/JEK	4955

23364 7590 07/12/2006

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EXAMINER
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TORRES VELAZQUEZ, NORCA LIZ

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/866,598

Applicant(s)

COSENTINO, DOMENIC

Examiner

Norca L. Torres-Velazquez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/28/05 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 24, 2006 has been entered.

### ***Drawings***

2. The replacement sheet of the drawings filed on June 28, 2005 is not acceptable. The amendment of the drawings includes features that were not originally disclosed in the specification.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over NUSSBAUM (US 4,830,892) in view of PONCHAUD et al. (US 5,604,006) and COSCIA et al. (US 4,781,952) as stated in previous action.

NUSSBAUM relates to a molding strip having an integrally formed insert with indicia. The molding strip includes an elongated plastic strip having an aperture formed therein. An insert is positioned in the aperture. (Abstract) The reference teaches that their invention can be

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used as fascia trim, especially for automotive vehicles. (Col. 1, lines 9-12) The reference shows a molding strip 10 that may be in the form of a substrate 18 having a metallized film 20 secured or bonded thereon. Substrate 18 can comprise polyvinylchloride or any other conventional material suitable for the intended use of molding strip 10. Indicia 14 further include a clear or tinted transparent plastic overlayer 22. The insert 24 is positioned within an aperture formed in the molding strip. The reference teaches that the insert 24 can be fabricated from polyvinylchloride or other suitable material. (Col. 2, lines 42-68 through Col. 3, lines 1-5) NUSSBAUM further teaches that the insert member 24 have a similar size and shape to aperture 26. (Col. 3, lines 26-28)

The Examiner equates the molding strip 10 with an aperture 26 to the main plate of the present invention with an opening, and insert member 24 to the insert plate of the present invention. It is noted that the material and/or finish of the molding strip and the insert member of the reference are different.

However, the reference is silent to the use of a backing member that comprises at least one adhesive element on a surface opposite a surface upon which the main plate is mounted.

PONCHAUD et al. teaches a composite article 10 that includes a decorative insert, inlay, foil or preform 12 having an exterior surface 14 and an interior surface 15 (Fig. 3) to which is firmly secured a thermoplastic body 18. The label 16 includes a thermoplastic layer 20. The label 16 is recessed into the exterior surface 14 of the decorative insert 12, and can either be partially recessed into the decorative insert 12 or fully recessed into the decorative insert 12. (Column 2, lines 63-67 through Column 3, lines 1-25) The decorative insert 12 comprises a thin sheet of thermoplastic material and the reference further teaches that it can also comprise a

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thermoplastic substrate, which has a wood grain print on its exterior surface. (Column 4, lines 23-43) It is the Examiner's interpretation that the composite article taught by the reference provides a similar product to the one taught by NUSSBAUM and provides a thermoplastic body 18 that equates to the backing member of the present invention.

However, PONCHAUD et al. fails to specifically teach the use of an adhesive element on the backing member on a surface opposite a surface upon which the main plate is mounted.

COSCIA et al. is directed to a decorative article for use in automobile surfaces such as those in the passenger compartment. (Column 1, lines 13-20) The reference teaches the use of various substrates and teaches that means for mounting may include a layer of adhesive material and teaches the use of a pressure sensitive adhesive. (Column 3, lines 10-14)

Since the references are directed to decorative articles for use in trim applications for automobiles, the purpose disclosed by COSCIA et al. and PONCHAUD et al. would have been recognized in the pertinent art of NUSSBAUM.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the molding strip of NUSSBAUM and provide it with a backing member (thermoplastic body 18) such as that taught by PONCHAUD et al. and further provide it with an adhesive element/layer such as pressure sensitive adhesive with the motivation of providing a means for mounting the molding strip article to the automobile surface without the use of fasteners as disclosed by COSCIA et al. (Refer to Column 1, lines 17-19 and Column 3, lines 10-14).

***Response to Amendment***

5. The amendment to the claims and the Specification filed 4/24/06 has been considered and entered. As a results, the 35 U.S.C. 112, first paragraph rejection of the claims and the objection to the Specification under 35 U.S.C. 132(a) has been withdrawn herein.

***Response to Arguments***

6. Applicant's arguments filed April 24, 2006 have been fully considered but they are not persuasive.

a. The objection to the drawings is maintained herein as the reference numeral 20 was not described in the original Specification or drawings.

b. Applicants argue that the Nussbaum patent does not disclose a “decorative main plate” and a distinct “decorative insert plate” having “an outerside adjacent to the first surface of the main plate” such that the insert plate is inherently removable in order to be exchanged for another distinct insert plate. Applicants further conclude that because the insert member 24 of the Nussbaum patent is not removable from the molding 10, the patent does not disclose all of the limitations required by the pending claim 1.

It is the Examiner's position that Applicant's arguments are not commensurate in scope with the claims because the claims do not require the insert plate to be “removable” in the manner argued. Further, with regards to Applicant's argument that the insert plate is not removable, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987). It is the Examiner's interpretation that the teachings of the prior art of record provide an insert plate and the main plate claimed herein and that it is possible to remove the insert from the main plate if desired. If one wanted to remove the

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insert plate from the structure of Nussbaum, one could remove the transparent overlay applied to seal the insert member in place and then remove the insert plate from the main plate.

c. With regards to arguments over the Ponchaud et al. and the Coscia et al. patents, it is noted that the Examiner is not bodily incorporating the structures of these references into the structure of Nussbaum, but providing the structure of Nussbaum with a backing member such as that taught by Ponchaud et al. in order to provide a support surface for the molding strip of Nussbaum, further the Examiner relies on the teachings of Coscia et al. to provide an adhesive material as a means for mounting the structure for example, in automobile surfaces without the use of fasteners. It is noted that the cited references relate to decorative articles for use in trim applications for automobiles, therefore, the purpose disclosed by Coscia et al. and Ponchaud et al. would have been recognized in the pertinent art of Nussbaum.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

CASAGRANDE (US 6,352,287 B2)

FISCHER (US 5,736,212)

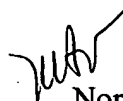
FISCHER (US 6,190,747)

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 571-272-1484. The examiner can normally be reached on Monday-Thursday 8:00-5:00 pm and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Norca L. Torres-Velazquez  
Primary Examiner  
Art Unit 1771

July 7, 2006